



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,424	09/25/2001	Mitsuru Yamamoto	00862.022388.	6884

5514 7590 11/10/2010
FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK, NY 10104-3800

EXAMINER

RUSTEMEYER, BRETT J

ART UNIT	PAPER NUMBER
----------	--------------

2426

MAIL DATE	DELIVERY MODE
-----------	---------------

11/10/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/961,424	Applicant(s) YAMAMOTO, MITSURU	
	Examiner BRETT RUSTEMEYER	Art Unit 2426	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on September 22, 2010 has been entered.
2. This Office Action is in response to an AMENDMENT entered September 22, 2010 for the patent application, 09/961,424, filed September 25, 2001.

Status of Claims

3. Claims 38 and 43 are pending.

Claim Objections

4. Claims 38 and 43 are objected to for the minor informalities:
 - a. Claim 38 recites the limitation "b) to compare the first confirmation data transmitted by said confirmation data transmission unit to cause the first display terminal to display the first confirmation data with the second confirmation data input in the first control terminal by the user." The limitation should be amended to "b) to compare the first confirmation data₂ transmitted by said confirmation data transmission unit to cause the first display terminal to display the first confirmation data₂ with the second confirmation data input in the first control

Art Unit: 2426

terminal by the user” for clarity. Similar considerations apply to claim 43.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 38 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the limitations of “*the confirmation result*” lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Final Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in **Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966)**, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: (*See MPEP Ch. 2141*)

- a. Determining the scope and contents of the prior art;
- b. Ascertaining the differences between the prior art and the claims in issue;
- c. Resolving the level of ordinary skill in the pertinent art; and
- d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.

Art Unit: 2426

8. Claims 38 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,574,798 B1, to Bradley et al. (hereinafter “**Bradley**”) in view of U.S. Patent 5,497,186, to M. Kawasaki (hereinafter “**Kawasaki**”).

Examiner's Note (EN): The combined teaching of **Bradley** and **Kawasaki** applies with specific sections identified as follows. 14 ¶ applies.

Regarding claim 38,

Bradley reads on (in *italics*):

A video server which is connected to a plurality of control terminals via a first transmission path, and which is connected to a plurality of display terminals via a second transmission path {Bradley, FIGS. 2, 6, C 6: L 16-23, 28-31, C 14: L 32-40; EN: wherein the global authorization computer (GAC) reads on the video server, since it "administers the video system"; the transmission path connecting the customer location to the GAC reads on the first transmission path; and the local distribution network connecting (See FIG. 6) the customer location to the GAC via the local source of video signals reads on the second transmission path}, the video server comprising:

a first reception unit configured to received a video request from a first one of the plurality of control terminals via the first transmission path, wherein the video request comprises video designation data designating video data to be displayed on a display terminal, display terminal designation data designating a first display terminal on which the video data is to be displayed, and first identification data identifying the first control terminal that transmitted the video request {Bradley, FIGS. 2, 7a, C 6: L 16-23, C 15: L 59 – C 17: L 4; EN: wherein the interactive voice response (IVR) interface reads on the

Art Unit: 2426

first reception unit; the telephone at the customer location reads on the *first control terminal*; the telephone call reads on the *video request*; the pay-for-use selection indicating desired video signals, optional services, and/or lengths of time reads on the *video designation data*; the room number or pre-assigned television number reads on the *display terminal designation data*; and the caller identification (ID) received or telephone number of the room entered on the keypad reads on the *first identification data*};

a generating unit configured to generate first confirmation data for confirming the first display terminal by a user of the first control terminal (**Bradley**, FIGS. 2, 7a, C 16: L 53-57, C 17: L 14-16; EN: wherein elements of the GAC used to confirm selections back via IVR to the user reads on the *generating unit configured to generate first confirmation data*. Additionally or alternatively, refer to elements of the GAC used to prepare an authorization packet comprising authorized room identification, authorized channel identification, and authorized period of time. See **Bradley**, C 14: L 67 - C 15: L 10, C 17: L 17-20);

a confirmation data transmission unit configured to transmit [...] the first confirmation data generated by said generating unit to the [...] [first control terminal corresponding to] the first display terminal designated by the display terminal designation data, and to cause [...] [the output of] the first confirmation data (**Bradley**, FIGS. 2, 7a, C 16: L 53-57, C 17: L 14-16; EN: wherein elements of the GAC used to generate IVR signals confirming selections back to the user (as previously described) reads on the *confirmation data transmission unit configured to transmit the first confirmation data*. Additionally or alternatively, elements of the GAC used to forward the authorization packet (as previously described) to the user's telephone line/television

Art Unit: 2426

control interface reads on *confirmation data transmission unit configured to transmit the first confirmation data*— See **Bradley**, C 14: L 67 - C 15: L 10, C 17: L 17-20};

a confirmation data reception unit configured to receive second confirmation data from the first control terminal which transmitted the video request received by the first reception unit, wherein the second confirmation data is input in the first control terminal by a user based on the first confirmation data [...] [output at the first control terminal corresponding to] the first display terminal {**Bradley**, FIGS. 2, 7a, C 16: L 53-57, C 17: L 14-16, 50-52, C 23: L 7-10; EN: wherein the user input confirming the room or pre-assigned television number and their selections via the telephone keypad (applied to either interpretation) reads on *receive second confirmation data from the first control terminal which transmitted the video request received by the first reception unit, wherein the second confirmation data is input in the first control terminal by a user based on the first confirmation data*}, and to receive second identification data of the first control terminal that transmitted the second confirmation data {**Bradley**, FIGS. 2, 8a, C 16: L 30-36; EN: wherein elements of the GAC are used to access the database record of the institution corresponding to the received or user input telephone number reads on the *second identification data*};

a confirmation unit configured to

a) compare the first identification data of the first control terminal that transmitted the video request with the second identification data of the first control terminal that transmitted the second confirmation data (**Bradley**, FIGS. 2, 7a, 8a, C 16: L 15-36, 45-52; EN: wherein elements of the GAC used to compare database records of the institution with the telephone number received through caller ID or input by a user

Art Unit: 2426

through their keypad reads on the *confirmation unit configured to compare the first identification data ... with the second identification data; See Steps 170, 176, and 180*),

b) to compare the first confirmation data transmitted by said confirmation data transmission unit to cause [the first control terminal corresponding to] the first display terminal to [...] [output] the first confirmation data with the second confirmation data input in the first control terminal by the user {Bradley, FIGS. 2, 7a, C 16: L 53-57, C 17: L 14-16, 50-52, C 23: L 7-10; EN: wherein elements of the GAC verify the user input confirming the room or pre-assigned television number and their selections via the telephone keypad is affirmative and/or appropriate. In other words, a user provides an input via their telephone keypad to via the IVR system of the GAC wherein the input represents (i) the room or pre-assigned television, and (ii) the user's selection (e.g., desired video signals, optional services, and/or lengths of time). Elements of the GAC use this input to determine whether or not the user has confirmed the IVR prompts requesting the user confirm their room or pre-assigned television number and selections, in order for the GAC to proceed to the next step of the routine. According to the interpretations described above, the user's input confirming the user's selections may occur either at (a) confirm[ing] the selection back to the user, (b) confirming its correct operation upon receipt of the authorization packet, and/or (c) in a call back to the user confirming h[e]r selection and parameters}; and

c) to confirm that the user of the first control terminal has designated the correct display terminal according to a comparison result of the comparison a) and the comparison b) (Bradley, FIGS. 2, 7a, C 16: L 53-57, C 17: L 14-16, 50-52, C 23: L 7-10; EN: wherein elements of the GAC confirm the user input confirming the room or pre-

Art Unit: 2426

assigned television number and their selections via the telephone keypad is affirmative and/or appropriate. *See also* **Bradley**, FIGS. 2, 6, 7a, 7b, C 16: L 48-52, C 17: L 14-16, 53-65, C 23: L 14-18); *and*

*a video data transmission unit configured to transmit, via the second transmission path, the video data designated by the video designation data to the first display terminal designated by the display terminal designation data, to display the video data (**Bradley**, FIGS. 2, 6, 7c, C 14: L 32-46, C 18: L 16-22), if the video server confirms that the user of the first control terminal has correctly designated the first display terminal according to the confirmation result (**Bradley**, FIGS. 2, 7a, C 16: L 53-57, C 17: L 14-16, 50-52, C 23: L 7-10; EN: wherein elements of the GAC confirm the user input confirming the room or pre-assigned television number and their selections via the telephone keypad is affirmative and/or appropriate. *See also* **Bradley**, FIGS. 2, 6, 7a, 7b, C 16: L 48-52, C 17: L 14-16, 53-65, C 23: L 14-18)*

Bradley is silent on:

[...] a confirmation data transmission unit configured to transmit, via the second transmission path the first confirmation data [...] to the first display terminal [...], and to cause the first display terminal to display the first confirmation data;

[...] wherein the second confirmation data is input [...] based on the first confirmation data displayed on the first display terminal [...]

[...] the first confirmation data transmitted by said confirmation transmission unit to cause the first display terminal to display the first confirmation data [...]

Art Unit: 2426

Kawasaki reads on:

a confirmation data transmission unit configured to transmit, via the second transmission path the first [...] [message] data [...] to the first display terminal [...], and to cause the first display terminal to display first [...] [message] data (Kawasaki, FIG. 2, C 1: L 7-10, 22-40, C 2: L 45 – C 3: L 28; EN: wherein the communication controller reads on the confirmation data transmission unit);

[...] wherein [...] confirmation data is input [...] based on the [...] first [message] data is displayed on the first display terminal [...] (Kawasaki, C 5: L 4-8);

[...] the first [...] [message] data transmitted by said confirmation data transmission unit to cause the first display terminal to the first [...] [message] data [...](Kawasaki, FIG. 2, C 1: L 7-10, 22-40, C 2: L 45 – C 3: L 28; EN: wherein the communication controller reads on the confirmation data transmission unit).

Rationale:

Because both **Bradley** and **Kawasaki** teach methods to transmit messages, e.g., voice prompts via IVR, and announcement picture data via video signal, respectively, it would have been obvious to one ordinarily skilled in the art to apply the technique of transmitting message commands comprising announcement picture data in the form of a character strings through a hotel video distribution system for display on a particular terminal address as described by **Kawasaki** to improve the respective functionality of the GAC, local video source, and television control interface in confirming user selections as disclosed by **Bradley** for the predictable result of displaying a user's input on their

Art Unit: 2426

display unit in order to enable the user to more readily confirm their input telephone keypad interface.

Regarding claim 43, the method is inherent of the system and its claimed functionality.

Response to Arguments

9. Applicants' amendment to the claims documented in the Applicants' submission pertaining to the objection to claims 38 and 43 has been fully considered and is persuasive. The objection to claims 38 and 43 is herein removed, however, a new grounds of objection is set forth in this Office action.

10. Applicants' arguments and remarks documented in the Applicant's submission pertaining to the 35 U.S.C. § 103(a) rejection of claims 38 and 43 have been considered, but are moot in view of the new ground(s) of rejection.

In reference to the Applicants' argument(s):

"This application has been carefully reviewed in light of the Office Action dated June 23, 2010. Claims 38 and 43, each of which are independent, remain in the application. Reconsideration and further examination are respectfully requested.

Claim 38 was objected to for an informality that has been attended to by amendment. Reconsideration and withdrawal of the objection are respectfully requested.

Claims 38 and 43 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,574,798 (Bradley) in view of U.S. Patent No. 5,497,186 (Kawasaki). Reconsideration and withdrawal of the rejections are respectfully requested in light of the following comments.

[...]

Bradley discloses delivering pay video data in which the video data is transmitted to a display device designated by a user. **Bradley is not, however, seen to teach anything in which a video server receiving the request, generates the first confirmation data to be displayed on the designated display terminal, or that the user inputs second confirmation data by viewing the first**

Art Unit: 2426

confirmation data, or that the video server receives the second confirmation data, and compares it with the first confirmation data and also compares the identification data of the terminal transmitting the request and the second confirmation data, so that the server can confirm that the user has designated the correct display terminal. The Office Action more or less admits at pages 7 and 8 that **Bradley fails to teach the features of the generating unit and the first confirmation transmitting unit. As such, it is not seen how Bradley could possibly then teach the features of the user inputting the second confirmation data based on the first confirmation data displayed on the display terminal since, as admitted, the first confirmation data is not transmitted to the display terminal in Bradley.** As a result, the remaining elements of the claims, where are more or less connected with the foregoing, could also not be taught by Bradley. Therefore, Bradley is not seen to teach the features of the claims.

Kawasaki simply teaches that a message directed to a particular terminal is transmitted with a television broadcast signal, whereby the terminal displays the message on a TV receiver, and finishes the display when the user issues an instruction indicating that the message has been received. Thus, at best, Kawasaki transmits a message to a particular terminal and the user confirms receipt of the message. However, **Kawasaki is not seen to teach that a video server, upon receiving a request for designated video data, generates first confirmation data and transmits it to a designated display terminal, whereby a user inputs second confirmation data that is transmitted to the server, along with identification data of the control terminal transmitting the second confirmation data, so that the video server then compares the first and second confirmation data, and the first and second identification data in order to confirm that the user has designated the correct display terminal.** Thus, Kawasaki is not seen to make up for the deficiencies of Bradley and the proposed combination would not have resulted in the presently claimed invention.

In view of the foregoing amendments and remarks, Claims 38 and 43 are believed to be allowable.

No other matters having been raised, the entire application is believed to be in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience [...]"

Examiner's Response:

¶ 14 below applies. Applicants' assertions are herein acknowledged. In response to Applicants' assertions against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In particular,

Kawasaki is relied upon herein to teach the technique of transmitting message commands comprising announcement picture data in the form of a character strings through a hotel video distribution system for display on a particular terminal address. While none of the disclosed IVR prompts are displayed on the user's television in **Bradley**, one of ordinary skill in the art would have recognized that displaying a message for user confirmation is generally preferable to a user trying to understand and confirm a computer generated audio message. Using this knowledge, the respective functionality of the GAC, local video source, and television control interface of **Bradley** can readily be improved upon by incorporating the respective functionality of control computer, communication controller, and user terminal apparatus of **Kawasaki** in the transmission of server messages to a user. Thus, the combined teaching enables the GAC to transmit one or more visual prompts to the user via the local distribution network (*See* FIGS. 2 and 6) to a television for display in a particular customer location to enable a user to readily confirm one or more selections input through the telephone located in the customer location. For reasons set forth in this Office Action, Examiner respectfully submits this 35 U.S.C. § 103(a) rejection of claims 38 and 43.

Examination Considerations

11. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure." *In re Morris*, 127 F.3d 1048, 1054-1055, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). "Limitations appearing in the specification but not recited in

Art Unit: 2426

the claim are not read into the claim.” *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969) (MPEP p 2100-8, C 2: L 45-48; p 2100-9, C 1: L 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

12. Examiner’s Notes are provided with the cited references to prior art to assist the Applicant(s) to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art which may be applied in future Office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art, but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

13. Unless otherwise annotated, Examiner’s statements are to be interpreted in reference to that of one of ordinary skill in the art. Statements made in reference to the condition of the disclosure constitute, on the face of it, the basis and such would be obvious to one of ordinary skill in the art, establishing thereby an inherent prima facie statement.

14. Examiner’s Opinion: ¶ 11-13 apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this Final Office Action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Claims 38 and 43 are rejected.

Contact

17. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Brett Rustemeyer whose telephone number is (571) 270-1849. The examiner can normally be reached on Monday - Friday 9:00 a.m.-5:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Joseph Hirl can be reached on (571) 272-3685. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

Art Unit: 2426

Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BR/

Examiner – Art Unit 2426

November 6, 2010

/Joseph P. Hirl/

Supervisory Patent Examiner, Art Unit 2426

November 8, 2010